



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/626,682 | 07/24/2003 | Byung-Wook Kim | 678-1232 (P11297) | 1050 |
| 28249 | 7590 | 11/15/2005 | | EXAMINER |
| DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553 | | | KARIKARI, KWASI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2686 | |

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/626,682 | KIM ET AL. | |
| | Examiner | Art Unit | |
| | Kwasi Karikari | 2686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 May 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under U.S.C. 103(a) as being unpatentable over Wilson et al., (U.S. 20040167968 A1), (hereinafter Wilson) in view of Kirsch (U.S. 20040177120 A1), (hereinafter Kirsch) and further in view of Allison et al., (U.S. 6,819,932), (hereinafter Allison).

Regarding **Claim 1**, Wilson discloses a method for blocking spam messages (spam message) in a server (spam blocking server (102)), comprising the steps of:

a) when a message and its corresponding message phone number to be transmitted to a subscriber of a mobile communication terminal [electronic communication link, **see** Pars. [0022-0023]) is received from a base station (a system, **see** Par. [0013])

b) accessing a spam-blocking information database, and searching for a the SMS message phone number (signature or essential information) to determine if the

SMS message phone number registered in the spam-blocking Information data base (Fig. 1, item 102) and (signatures are looked up in the database, **see** Par. [0023]);

c) if the message phone number is registered in the spam-blocking information database ending the procedure for the received message without performing message processing for services on the received message (appropriate action being taken, step 210 of Fig.2, when matching signatures are found in database, Par. [0023]) **but fails teach SMS spam messages and determining if a spam blocking option is set.**

Kirsch discloses a method of filtering email messages (**see** Par. [0010]). Kirsch further teaches the decision of categorizing a received email message as wanted or unwanted based on words appearing in the subject header (**see** Pars. [0024-0025] and Fig. 2, blocks 28 and 30).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Kirsch with the system of Wilson for the benefit of achieving an email filtering system that could identify and stopped spam messages with forged or inappropriate identities.

However, the combination of Wilson and Kirsch fails to teach SMS spam messages. Allison teaches a system that prevents the delivery of unwanted SMS messages (**see** col. 4, lines 37-55).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 2**, Wilson discloses a method for blocking spam messages in an server [102], comprising the steps of:

- a) when a message to be transmitted to a subscriber of a mobile communication terminal is received from a base station [steps 200-206 in Fig.2];
- b) determining if the received message includes a **predetermined word** (using a previously built-up knowledge of spam messages to block a subsequent spam, **see Par. [0016]**) said predetermined word being prestored in database (system uses build knowledge from spam and store information in the database, **see Pars [0016 and 0017]**) and;
- c) if the received message includes a predetermined word (essential information or signature), ending the procedure for the received message without performing message processing for services on the received message (if signature matches are found in database, then some appropriate action is taken, **see Par. [0023]**), **but fails to teach SMS message and determining if a spam blocking option is set.**

Kirsch discloses a method of filtering email messages (**see Par. [0010]**). Kirsch further teaches the decision of categorizing a received email message as wanted or unwanted based on words appearing in the subject header (**see Pars. [0024-0025]** and Fig. 2, blocks 28 and 30).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Kirsch with the system of Wilson for the benefit of achieving an email filtering system that could identify and stopped spam messages with forged or inappropriate identities.

However, the combination of Wilson and Kirsch fails to teach SMS spam messages.

Allison teaches a system that prevents the delivery of unwanted SMS messages (see col. 4, lines 37-55).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 3**, Wilson discloses method for blocking spam messages in a mobile communication terminal [email device, (106 and 100)], comprising the steps of:

a) when an message [email message] is received, and c) when it is determined that the received message is a spam message controlling the terminal so as not to notify receipt of the message (action is taken or message is deleted, see step 210 in Fig. 2 and Par. [0025]), **but fails to teach SMS message and determining if a spam blocking option is set.**

Kirsch discloses a method of filtering email messages (see Par. [0010]). Kirsch further teaches the decision of categorizing a received email message as wanted or unwanted based on words appearing in the subject header (see Pars. [0024-0025] and Fig. 2, blocks 28 and 30).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Kirsch with the system of Wilson for the benefit of achieving an

Art Unit: 2686

email filtering system that could identify and stopped spam messages with forged or inappropriate identities.

However, the combination of Wilson and Kirsch fails to teach SMS spam messages.

Allison teaches a system that prevents the delivery of unwanted SMS messages
(see col. 4, lines 37-55).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 4**, Wilson discloses the method as set forth in claim 3, further comprising the step of;

d) determining if a spam message is set to be stored (update), after blocking the message-receipt notification, and storing the received spam message if it is determined that the spam message is to be stored (blacklist is updated for the purpose of blocking spam message and if signature is not found, then message is processed,

see Pars. [0017 and 0024]), but fails to teach SMS message.

Allison teaches a system that prevents the delivery of unwanted SMS messages
(see col. 4, lines 37-55).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the

Art Unit: 2686

benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 5**, Wilson discloses the method as set forth in claim 3, wherein a phone number [essential information] of a spam-message sender (sender address is added to the blacklist, **see Par. [0025]**) is registered in the spam-blocking information database, and said step a) further includes the step of:

a-1) detecting [matching signature] an message send phone number from the received message, and determining the message phone number is registered in the spam-blocking information database (if matching signature is found in the database, **see Par. [0023], but fails to teach SMS message.**

Allison teaches a system that prevents the delivery of unwanted SMS messages (**see col. 4, lines 37-55**).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 6**, Wilson disclose the method as set forth in claim 3, wherein a predetermined word (essential information] is registered in the spam-blocking information database (104), and said step a) further includes the step of:

Art Unit: 2686

a-2): determining if the registered predetermined word is included in the received message (signatures are sent to a database, **see Par. [0017]**), **but fails to teach SMS message.**

Allison teaches a system that prevents the delivery of unwanted SMS messages (**see col. 4, lines 37-55**).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 7**, Wilson discloses the method as set forth in claim 3, wherein a phone number of a spam message sender (sender address is added to the blacklist, **see Par. [0025]**) and a predetermine word [signature] implying a spam message are registered in the spam-blocking information database [104], and said step a) further includes the steps of

a-1) detecting a message phone number from the received message, and determining if the message phone number registered in the spam-blocking information database (spam blocking server look for signature in the database, **see Par. [0018]**) and;

a-2) determining if the registered predetermined word (essential information)is included in the received SMS message [**see step 206 in fig.2**], **but fails to teach SMS message.**

Allison teaches a system that prevents the delivery of unwanted SMS messages

(see col. 4, lines 37-55).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Regarding **Claim 8**, according to claim 3, Allison further discloses reading a previously stored warning message, from the database, and transmitting the previously stored warning message to a call back number detected from the SMS message (stored information that indicates a new message to alert the originator of the discarded spam SMS message that the spam was not delivered and additional message should not be sent to the intended recipient, see col. 12, lines 47-60).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Allison with the combination of Kirsch and Wilson for the benefit of achieving a system that could prevent the unwanted delivery of SMS messages.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Song et al. (U.S 2003/0225841) discloses a system and method of preventing spam mails.

Bates et al. (U.S 6,779,021) discloses a method and system for predicting and managing undesirable electronic mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571- 272 5905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwasi Karikari
Examiner


CHARLES APPIAH
PRIMARY EXAMINER